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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,429	03/25/2004	Shyh-Kwei Chen	YOR920040052US1	6945
48150 7590 02/16/2007 MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			EXAMINER JOHNSON, JOHNESE T	
			ART UNIT	PAPER NUMBER

2166

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/808,429

Applicant(s)

CHEN ET AL.

Examiner

Johnese Johnson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>25 March 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 1 and 33 are objected to because of the following informalities:

Claim 1 does not set forth a plurality of elements or steps; and, each of the elements or steps of the claim are not separated by a line indentation (See MPEP 608.01(m) [R-3]).

Claim 33 recites both a method and computer readable code but does not list any steps (only "instructions ") therefore, the examiner is reading the claim as an apparatus claim for the purposes of examining.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for business object discovery , does not reasonably provide enablement for discovering an object definition. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to create the invention commensurate in scope with these claims.

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3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: as shown in Figure 3 of the drawings, items 310, 320, 330, 340, 350, 360, and 370.

5. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble of claim 13 recites, "a system for discovering...". The act of discovering an object is never realized in the body of the claim; thus, there is no nexus between the intended use of the preamble and the body of the claim.

6. Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 33 recites a "method for deploying" and "the computer readable code comprising", in the preamble, and "instructions for" as steps of the claim. The examiner is not sure if the claim is a method claim or an apparatus claim. If the claim is indeed a method/ process, the claim must include steps (not "instructions for").

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1, 7-9, 11, 13-19, 20, 25, and 33 are rejected under 35 U.S.C. 101

because the claimed invention is directed to non-statutory subject matter.

Claims 1, 25, and 33 fail to produce any useful, concrete, and tangible results.

The last step of claim 1 is a determining step. The act of determining does not produce any results. As to claim 25, the last step is requesting. Although the last step requests data, the claim does not disclose what happens after the request has been made (i.e., data is stored, etc...). As to claim 33, "instructions for" are not steps in a process or method, but imply the intended use of the limitation and therefore do not produce any results.

Claims 7-9, 11, 13-19, and 20 are directed to software modules which are *software per se*. *Software per se* is also known as functional descriptive material (See *in re Warmerdam*, 33 F3d at 1360, USPQ2d at 1759). The content is not structurally and functionally interrelated to a computer-readable medium thereby rendering it incapable of producing a useful, concrete and tangible result and is therefore non-statutory.

Claims must be amended to recite hardware in the body.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Burke et al. (US Pat. No. 6,789,252).

As to claim 1, Burke et al. disclose:

determining an object definition for an object based upon a collaboration code (see col. 17, lines 48-49).

As to claim 2, Burke et al. disclose:

receiving said object and said collaboration code (see col. 34, lines 26-28 and 37-42).

As to claim 3, Burke et al. disclose:

wherein said object definition comprises a business object definition and said object comprises a business object (see col. 34, lines 26-28 and 37-42).

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As to claim 4, Burke et al. disclose:

forwarding said object and said object definition (see col. 34, lines 45-48).

As to claim 5, Burke et al. disclose:

wherein said forwarding comprises forwarding said object and said object definition to an application adapter (see col. 34, lines 26-28 and 37-42 and col. 42, lines 64-66).

As to claim 6, Burke et al. disclose:

processing said object based upon said object definition in said application adapter (see col. 6, lines 20-21).

As to claim 7, Burke et al. disclose:

wherein said collaboration code determines how data from a second object is mapped to said object (see col. 21, lines 1-8).

As to claim 8, Burke et al. disclose:

wherein said collaboration code determines how said object is derived from said second object (see col. 21, lines 1-5).

As to claim 9, Burke et al. disclose:

wherein said collaboration code determines how said object is derived from said second object and a second object definition (see col. 21, lines 1-5).

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As to claim 10, Burke et al. disclose:

further comprising receiving said second object definition (see col. 34, lines 26-28 and 37-42 and col. 21, line 3 – second object).

As to claim 11, Burke et al. disclose:

wherein said determining comprises determining said object definition for said object based upon said collaboration code and said second object definition (see col. 17, lines 48-49 and col. 21, line 3 – second object).

As to claim 12, Burke et al. disclose:

wherein said receiving comprises receiving said object and said collaboration code from a broker (see col. 34, lines 26-28 and 37-42; wherein the means allows data to be exchanged/ integrated in different formats).

As to claim 13, Burke et al. disclose:

means for receiving an object and a collaboration code (see col. 34, lines 26-28 and 37-42); and means for determining an object definition for said object based upon said collaboration code (see col. 17, lines 48-49).

As to claim 14, Burke et al. disclose:

wherein said object definition comprises a business object definition and said object comprises a business object (see col. 34, lines 26-28 and 37-42).

As to claim 15, Burke et al. disclose:

means for forwarding said object and said object definition to an application adapter
(see col. 34, lines 26-28 and 37-42 and col. 42, lines 64-66).

As to claim 16, Burke et al. disclose:

wherein said collaboration code determines how data from a second object is mapped
to said object (see col. 21, lines 1-8).

As to claim 17, Burke et al. disclose:

means for receiving a second object definition, wherein said collaboration code
determines how said object is derived from said second object and said second object
definition (see col. 21, lines 1-5).

As to claim 18, Burke et al. disclose:

wherein said means for determining comprises means for determining said object
definition for said object based upon said collaboration code and said second object
definition (see col. 17, lines 48-49 and col. 21, line 3 – second object).

As to claim 19, Burke et al. disclose:

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wherein said means for receiving comprises means for receiving said object and said collaboration code from a broker (see col. 34, lines 26-28 and 37-42; wherein the means allows data to be exchanged/ integrated in different formats).

As to claim 20, Burke et al. disclose:

a reverse object discovery agent that receives a first object and a collaboration code from a broker and that discovers a first object definition (see col. 34, lines 26-28 and 37-42).

As to claim 21, Burke et al. disclose:

a broker that receives a second object and a second object definition and that generates said first object using said collaboration code (see col. 34, lines 26-28 and 37-42 and col. 20, lines 21-23).

As to claim 22, Burke et al. disclose:

wherein said collaboration code determines how said first object is derived from said second object (see col. 21, lines 1-5).

As to claim 23, Burke et al. disclose:

wherein said collaboration code determines how said first object is derived from second object and said second object definition (see col. 21, lines 1-5).

As to claim 24, Burke et al. disclose:

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an application adapter that receives said first object and said first object definition from said reverse object discovery agent (see col. 34, lines 26-28 and 37-42 and col. 42, lines 64-66).

As to claim 25, Burke et al. disclose:

determining whether an object conforms to a known object definition (see col. 17, lines 48-49); and requesting a collaboration code and an input object definition if said object does not conform to a known object definition (see col. 34, lines 26-28 and 37-42; wherein the code and definition must be requested in order to be received).

As to claim 26, Burke et al. disclose:

analyzing said collaboration code and said input object definition (see col. 21, lines 1-8).

As to claim 27, Burke et al. disclose:

creating a new object definition based upon the results of said analyzing (see col. 20, lines 21-23).

As to claim 28, Burke et al. disclose:

forwarding said object if said object conforms to a known object definition (see col. 34, lines 45-48).

As to claim 29 Burke et al. disclose:

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wherein said object comprises a business object and said object definition comprises a business object definition (see col. 34, lines 26-28 and 37-42).

As to claim 30, Burke et al. disclose:

forwarding said new object definition to an application adapter (see col. 34, lines 26-28 and 37-42 and col. 42, lines 64-66).

As to claim 31, Burke et al. disclose:

receiving a subscription from said application adapter for said new object definition (see col. 50, lines 61-63; wherein the notification subscriptions are received and configured).

As to claim 32, Burke et al. disclose:

forwarding said object in response to said subscription (see col. 34, lines 45-48 and col. 50, lines 58-63).

As to claim 33, Burke et al. disclose:

instructions for receiving an object and a collaboration code (see col. 15, line 53 and col. 34, lines 26-28 and 37-42); and
instructions for determining an object definition for said object based upon said collaboration code (see col. 15, line 53 and col. 17, lines 48-49).

As to claim 34, Burke et al. disclose:

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wherein said object comprises a business object and said object definition comprises a business object definition (see col. 34, lines 26-28 and 37-42).

As to claim 35, Burke et al. disclose:

instructions for forwarding said new object definition to an application adapter(see col. 34, lines 26-28 and 37-42 and col. 42, lines 64-66).

As to claim 36, Burke et al. disclose:

instructions for receiving a subscription from said application adapter for said new object definition (see col. 15, line 53 and col. 50, lines 61-63; wherein the notification subscriptions are received and configured).

As to claim 37, Burke et al. disclose:

instructions for forwarding said object in response to said subscription (see col. 15, line 53, col. 34, lines 45-48 and col. 50, lines 58-63).


Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnese Johnson whose telephone number is 571-270-1097. The examiner can normally be reached on 4/5/9.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


09 February 2007
JJ


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER